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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/321,882 05/28/99 UFASANI

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EXAMINER

BADIO, B

ART UNIT

PAPER NUMBER

1616

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DATE MAILED:

06/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/321,882

Applicant(s)
Upasani et al.

Examiner
Barbara Badio

Group Art Unit
1616



☐ Responsive to communication(s) filed on _____.

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 25-27, 35-43, 46-53, and 55-61 is/are pending in the application.

Of the above, claim(s) 35-43, 47-53, 56, and 60 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 25, 26, 46, 55, 57, 58, and 61 is/are rejected.

☒ Claim(s) 27 and 59 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 10

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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Nonfinal Office Action on the Merits

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 25-27, 35-43, 46-53 and 55-61 are pending in the present application (note: claims 44 and 45 were canceled by applicant, see preliminary amendment). Claims 35-43, 47-53, 56 and 60 stand withdrawn from further consideration as being drawn to a non-elected invention. Claims 25-27, 46, 55, 57-59 and 61 will be examined to the extent they read on the elected species and obvious variants thereof.

Claim Objections

3. Claim 25 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 25 which is dependent on claim 46 recites R_3 "-C(O)-CH₂-O-Y'-Z-G".

Claim 46 does not include the group "-C(O)-CH₂-O-Y'-Z-G" instead it recites "-C(O)-CH₂-Y'-Z-G". It is suggested that the "-C(O)-CH₂-O-Y'-Z-G" be amended to read "-C(O)-CH₂-Y'-Z-G".

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Double Patenting

4. The rejection of claims 1 and 2 under the judicially created doctrine of obviousness-type double patenting over claims 1-21 of US Patent No. 5,925,630 is withdrawn.

Claim Rejections - 35 USC § 102

5. The rejection of claims 1 and 2 under 35 USC 102(b) over Hosoda et al. is made moot by the cancellation of the claims.
6. The rejection of claims 25, 26, 46, 55 and 57 under 35 USC 102(b) over Hosoda et al. is withdrawn.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 25, 26, 46, 55, 57, 58 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillipps et al. ('345).

Phillipps et al. teach a generic group of 3α -oxygenated pregnane-21-ether derivatives having useful anesthetic activity (see the entire article, especially col.3, lines 38-66). The reference teaches compounds such as 21-p-aminophenoxy- 3α -hydroxy- 5α -pregnane-11,20-dione (col. 16, example 6) and 21-benzyloxy- 3α -hydroxy- 5α -pregnane-11,20-dione (col. 21, example 19).

The instant claims differ from the reference by reciting compounds wherein 3β -substituent is an alkyl instead of a hydrogen atom. However, hydrogen and methyl are considered obvious variant in the steroid art and, thus, the substitution of methyl for hydrogen on a known compound is not a patentable modification absent unexpected or unobvious results. It is also well known in the art that compounds having similar structure have similar properties and, therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to make the compounds of Phillipps et al. having a methyl instead of a hydrogen in the 3β -position with reasonable expectation that the two compounds would have similar properties and, thus, would be useful as taught by the prior art.

In addition, the reference teaches further substitution such as substitution of an alkyl or an aralkyl group in the 2-position and, thus, positional isomers of the claimed compounds (col. 2, line 45 - col. 3, line 37). A compound which is isomeric with a prior

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art compound is unpatentable absence some unobvious or unexpected beneficial property not possessed by the prior art compound. In re Norris, 179 F.2d 970, 84 USPQ 458 (CCPA 1970).

Allowable Subject Matter

9. Claims 27 and 59 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

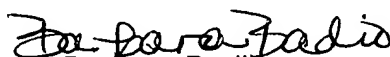
Note: The claims are allowable to the extent they read on the elected species and obvious variants thereof.

Telephone Inquiry Contacts

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Badio whose telephone number is (703) 308-4595. The examiner can normally be reached between 7:30 am and 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, José Dees, can be reached on (703) 308-4628. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.


Barbara Badio
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June 16, 2000